

REMARKS

Claims 1-6 and 8-13 are pending in the above application. Claims 5, 6, 8 and 9 have been withdrawn from consideration. By the above amendment, claim 7 has been cancelled.

The Office Action dated January 20, 2006, has been received and carefully reviewed. In that Office Action, claim 7 was rejected under 35 U.S.C. 102(e) as being anticipated by Tamura. By the above amendment, claim 7 has been cancelled. Claim 4 was objected to as being dependent upon a rejected base claim but was indicated to be allowable if rewritten in independent form. This has been accomplished by the above amendment. Claims 1-3, 10 and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of Parulski and Attenberg, and claims 12 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of Wu. Because it is believed that the art of record does not show or suggest the inventions required by the pending claims, reconsideration and allowance of claims 1-4 and 10-13 is respectfully requested.

THE EXAMINER'S RELIANCE ON "COMMON KNOWLEDGE" IS NOT PROPER

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of Parulski and Attenberg. The Office Action relies upon "common knowledge" of the following statement to justify combining these references: "...it is well known in the art that things that are united solidly probably are under a same housing." The standards for relying on common knowledge are set out in MPEP 2143.01 and are discussed below. It is respectfully submitted that no basis for relying on the above statement as "common knowledge" has been provided and that claim 1 is therefore allowable over the art of record.

The Office Action includes the statement that Tamura teaches unit 210 (a counter) and unit 220 (a printing device) are "united solidly." However, this language does not appear in the specification. Figure 4 shows the elements spaced apart and connected by an "order confirmation" line and an "information or order receiving" line. Under no reasonable meaning of the phrase "united solidly" are elements 210 and 220 of Tamura "united solidly." Therefore, it is respectfully submitted that this statement is not supported by the evidence of record. To the

extent that the rejection is based on this inaccurate statement, the rejection of claim 1 is respectfully traversed.

Next, the Office Action relies on “common knowledge” that things “united solidly are probably under a same housing.” As provided by MPEP 2143”.01, “Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While ‘official notice’ may be relied on, these circumstances should be rare when an application is under final rejection... (emphasis added).” Thus, this reliance on Official Notice in a final Office Action is either improper, or the record should show why this is one of the “rare” cases where official notice is needed.

The MPEP goes on to provide that “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known (emphasis added).” It is submitted that there is no basis for the above assertion in the record or otherwise. It therefore is certainly not capable of instant and unquestionable demonstration. Applicant therefore traverses this reliance on Official Knowledge and requests that the examiner provide documentary evidence in support of this statement if it is not withdrawn.

The MPEP also provides that “It is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.” The principle argument for combining Tamura and Parulski appears to be the above statement, contrary to the requirements of the MPEP.

Furthermore, “if official notice is taken of a fact, unsupported by documentary evidence, the technical line of reasoning underlying a decision to take such notice must be clear and unmistakable.” MPEP 2143.01. No technical line of reasoning, much less a clear and unmistakable technical line of reasoning, has been provided.

Finally, the MPEP provides that “if Applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the examiner must support the finding with adequate evidence.” Based on the above statements regarding the impropriety of the present reliance on Official Notice, Applicant hereby challenges the factual

assertion, quoted above, being relied upon in support of the present rejection. The rejection of claim 1 based on Tamura, Parulski and Attenberg is submitted to be improper, and the withdrawal of this rejection is respectfully requested.

A PROPER MOTIVATION FOR COMBINING THE REFERENCES
HAS NOT BEEN PROVIDED

The rejection of claim 1 is based on a combination of Tamura and Parulski and Attenberg. The Office Action acknowledges that Tamura does not show elements in a housing as claimed. However, Parulski and Attenberg are shown that it is possible to place multiple elements of a print system in a kiosk. It is respectfully submitted that a proper motivation for combining these references has not been provided. As provided in the MPEP, the fact that it might be possible to modify a reference does not constitute a basis for an obviousness rejection unless a motivation for making a combination or modification can be shown. MPEP 2143.01. It is therefore respectfully submitted that a proper motivation for combining references has not been shown, that a *prima facie* case of obviousness has not been presented, and that claim 1 is allowable over the references of record.

The Office Action offers several statement that may be intended to show a motivation to combine or modify references. It is respectfully submitted, however, that the Office Action may be confusing a desirable goal with a motivation that would lead a person to that goal. For example, reducing the cost of an existing product is generally considered desirable. This does not mean, however, that every method of reducing cost is obvious. In other words, the fact that a goal is desirable does not indicate that a particular means of attaining that goal is obvious. In the present case, the “motivations” for combining references are submitted to be no more than statement of goals. It is not even clear that these “goals” are recognized in the prior art – some seem to be taken from the present disclosure. Thus, the Office Action states a combination would be obvious “to reduce space such that rent would be reduced for commercial vendors.” There is no basis for this statement in the prior art, and even if true, it does not mean that every modification to a reference that saves space is obvious. It is further stated that “the system would be well protected.” This may be desirable, but the art of record in no manner suggests

inadequate protection is a problem that needs to be addressed. Finally, “let users know it a system as a whole for convenient.” This “goal” may be understood from the present disclosure, but it does not come from the references of record, and no explanation has been provided to show why this statement would be known to those skilled in the art.

For these reasons, it is respectfully submitted that a motivation for combining Tamura, Parulski and Attenberg has not been provided, that a *prima facie* case of obviousness has not been presented, and that claim 1 is allowable over the references of record.

Claims 2, 3, 10 and 11 depend from claim 1 and are submitted to be allowable for at least the same reasons as claim 1.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of Wu. Tamura is alleged to show all elements required by claim 12 except for a keypad for inputting a contact destination. Wu discloses a digital camera having a keypad 8. It is respectfully submitted that the fact a digital camera might have a keypad in no manner suggests replacing Tamura’s receiver 211 with a keypad. Moreover, the motivation for making this combination is unsupported by the art of record. It is respectfully submitted that even if the modification would have “allowed digital camera with keypad to make use of Tamura’s invention to increase the market share to increase profit,” this is a statement of an alleged result of the combination, not a motivation to make the combination in the first place. As discussed above, “increasing market share” is presumably desired by nearly all merchants; this does not mean that every invention that leads to an increased market share is obvious. A proper motivation for combining references has not been identified, a *prima facie* case of obviousness has not been presented, and claim 12 is submitted to be allowable over the art of record.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of Wu. This rejection is respectfully traversed for the reasons provided above in connection with claim 12.

CONCLUSION

Each issue raised in the Office Action dated January 20, 2006, has been addressed, and it is believed that claims 1-4 and 10-13 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: March 17, 2006

Respectfully submitted,

By 

Michael R. Cammarata

Registration No.: 39,491

Scott T. Wakeman 

Registration No.: 37,750

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorneys for Applicant